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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,038	07/12/2001	Robert A. MacDonald	KEY1025US	1936

7590

09/10/2002

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EXAMINER

YIP, WINNIE S

ART UNIT

PAPER NUMBER

3637

DATE MAILED: 09/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/904,038

Applicant(s)

MACDONALD ET AL. 

Examiner

Winnie Yip

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 July 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> | 6) <input type="checkbox"/> Other:  |

### DETAILED ACTION

This is a first office action for application Serial No. 09/904,038 filed July 12, 2001.

#### ***Information Disclosure Statement***

1. The information disclosure statement filed July 29, 2002 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it is an applicant's US co-pending application which is considered to a proper prior art. It has been placed in the application file, but the information referred to therein has not been considered as to the merits as a prior art reference.

#### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 15 and 34 are rejected under the judicially created doctrine of double patenting over claims 5, 16, and 19 of U. S. Patent No. 09/904,037 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter,

as follows: a retaining wall comprising a plurality of blocks arranged in at least one lower and upper courses, a geogrid, and a connector as claimed.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Claim Objections***

3. Claims 5 and 13 are objected to because of the following informalities:

In claim 5, the phrase “wherein the blocks comprise blocks of three different block widths” appears to read “wherein the wall comprises said blocks having three different block widths”.

In claim 13, line 11, “the block body” lacks a proper antecedent basis. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Bailey, II (US Patent No. 5,816,749).

Bailey shows and discloses a retaining wall comprising at least a first lower course (161) and a second upper course (162), each course comprising a plurality of blocks (10a', 10b', 10c'),

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each block (i.e. 10a', 10b', 10c') having upper and lower surfaces (20, 22), and front and rear faces (12, 18), the blocks have a same thickness, the lower surface (22) having two channels (38, 40) extended substantially parallel to the front and rear faces, the first front face (12) having an area greater than the second rear face such that the two opposed side surfaces (14, 16) being non-parallel. Wherein, the lower surface of the block (i.e., 210) may have a third channel (218) substantially parallel to the first front and second rear faces, the channels of the blocks are capably used to receive a horizontal reinforcement member as claimed, and the block may include the pin (i.e., 108 a-d) having a head portion (108a) and a body portion (106a), a geogrid (110 a-b), the upper surface of the block of lower course has at least one aperture (102) for receiving the body portion of the pin thereon to engage the geogrid between the blocks, and the head portion of the pin is received by one of the channel (40 a-d) on the lower surface of the block of upper course, and the block is configured to be capably placed in a reversibly position for construction of a wall which has a front surface of the wall formed of the first front faces of the blocks and a second rear surfaces of the wall formed of the second faces of other blocks as claimed.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-14, 16- 33, 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacDonald (US Patent No. 6,149,352) in view of Japanese Patent No. 10,290,444<sup>1A0</sup>.

MacDonald teaches a retaining wall comprising upper and lower courses, each course comprising a plurality of blocks, each block having an upper and lower surfaces (8,10) to define a block thickness, opposed and substantially parallel first and second faces (12, 14), the first face having an area greater than the second face such that opposed side surfaces (16,18) are non-parallel to each other, the lower surface of the block having a channel (23), the block having at least one core (20) and apertures (22a-f) to receive vertical reinforcing members or pins for fitting the blocks of upper course is aligned with the blocks of lower course. Wherein, the pin (80) may have a head portion (76) and a body portion (78) as claimed (see col. 7, lines 37-48). Macdonald further teaches, see Fig. 3B, the wall comprising the blocks with three different widths such that the blocks are capably positioned in the courses with the front surface of the wall is formed from the first faces of some blocks and from the second faces of the other blocks, and the wall includes a straight section and a corner section (see Fig. 2). Although, MacDonald does not define the block having at least two channels extending passed through the lower surface and substantially or parallel to the first and second faces for receiving horizontal reinforcing members therethrough. Japanese reference teaches a retaining wall comprising a plurality of blocks (1), each block may have three channels (3) formed on upper and lower surfaces (see Fig. 10) for positioning a plurality of horizontal reinforcing members (11a) or a geogrid passed through, and at least one core (3) extending vertically from the upper surface to the lower surface for receiving vertical reinforcing members (11a) passed through. It would have been obvious to one ordinary skill in the art at the time the invention was made to modify

the wall of MacDonald having blocks formed with at least two or three channels on the lower surface as taught by Japanese reference for positioning the horizontal reinforcing members or a geogrid passed through to provide a wall have no interfere with the vertical aligned blocks.

5. Claims 15 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wrigley et al. (US Patent No. 6,019,550) in view of Scales '523.

Wrogley et al. teach a retaining wall comprising upper and lower courses, each course comprising a plurality of blocks (1), each block having an upper and lower surfaces (5, 7) to define a block thickness, opposed and substantially parallel first front and second rear faces (2, 3), the first front face having an area greater than the second face such that opposed side surfaces (4, 5) are non-parallel to each other, the upper surface (6) of the block having a channel (12), at least one core (9), and apertures (10) to receive vertical reinforcing members or pins (11) for fitting the blocks of upper course being aligned with the blocks of lower course. Wherein, the pin (11) may have a head portion being received in an aperture on one block and a body portion being received in an other aperture on an other vertically aligned block (see Fig. 3), a geogrid (16) being attached on the channel (12) by a geogrid connector (13). Although Wrogley et al. does not define the channel being formed on the lower surface of the block such that the geogrid is connected to the channel from the lower surface of the block on the upper course as claimed, Scales teaches a retaining wall comprising blocks (14a, 14b) on the lower and upper courses, each block having at least one channel (26) formed on a lower surface of the block and having at least two channels (34, 35) formed on an upper surface of the block such that the channels of upper and lower blocks together form a larger channel for receiving and securing the geogrid

(70) by the geogrid connector (52). It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the wall of Wrigley et al. having blocks being reversibly displaced and aligned one vertically to another by the pins to form upper and lower courses as claimed as taught by Scales such that a geogrid would be secured to the lower surface of the upper block and extending outwardly between the channels between the upper and lower block.

### *Citations*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Scales et al. '663, Price et al. '295, Khamis '121, Miller et al. '460, Rainey '291, Borgersen et al. '934, teach various retaining walls having blocks connected with a geogrid as similar to the claimed invention. Sonnentag '599, Japanese Patent No. 4-353141 and Rassias et al. '440, various walls having blocks including different widths and channels as similar to the claimed invention.

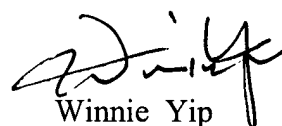
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 703-308-2491. The examiner can normally be reached on M-F (9:30-6:30), Second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Winnie Yip  
Patent Examiner  
Art Unit 3637

wsy  
September 5, 2002